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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,557	08/22/2001	Erik Gunther	GUNE117293	8854

26389 7590 08/25/2005

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EXAMINER

MARSCHEL, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/935,557

Applicant(s)

GUNTHER, ERIK

Examiner

Ardin Marschel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed ~~amendment(s)~~ ^{arguments} ~~new or amended claims would be rejected~~ is provided below or appended. ☐ will not be entered, or b) ☒ will be entered and an explanation of how the ~~new or amended claims would be rejected~~ is provided below or appended.
The status of the claim(s) is (or will be) as follows: remain
Claim(s) allowed: _____.
Claim(s) objected to: 3, 4, 10, 11, 33 and 34.
Claim(s) rejected: 1, 2, 6-9, 18-21, 32 and 35-37.
Claim(s) withdrawn from consideration: 5, 12-17 and 22-31.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
of reasons of record also explained further as attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: Attachment: Ex. Int. Sum. of 8/22/05

DETAILED ACTION

Further explanation of item # 11 on the enclosed Advisory action:

The rejection of claims 1, 2, 6-9, 18-21, 32, and 35-37 based on 35 USC 103(a) over Daniels et al. (P/N 6,368,794) is maintained and reiterated from the previous office action, mailed 3/9/05.

Applicant argues in REMARKS, filed 5/31/05, that the claimed methods encompasses the screening of compounds with a specific known drug action in order to identify novel drug action with potential pharmacological utility in other pathologies, pointing to the specification on page 14, lines 19-24. Applicant also argues that the specification on page 14, lines 19-30, indicates that the method of the invention does not include screening of established drug candidates in order to more fully characterize the utility for which they have already been indicated, and that uncharacterized analytes are included in the instantly claimed method and allege that Daniels et al. only screens already characterized therapeutic agents and therapeutic treatments. In response, a review of Daniels et al. reveals that several types of analytes or agents are screened therein via the expression profiling as instantly claimed. In particular, one type of analyte screened for treatment are sequences identified earlier in Daniels et al. as segments of such sequences as are responsive in disease expression profiling. For example, sequences 1-16 or those encoding sequences 17-23 are described in the SUMMARY OF THE INVENTION section in column 1, line 42, through column 2, line 64, as being selected from various samples via expression profiling. These sequences are not drug candidates but rather sequences selected from various samples. The so selected sequences are then described in column 2, line 65, through column 3, line 21, as being utilized for antisense technologies with other related therapeutic uses in amounts effective for treating disease, for example. Such therapeutic monitoring for

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efficacy, has previously been set forth in previous office actions, is described in column 10, line 54, through column 11, line 7. Thus, previously uncharacterized polynucleotides etc. are screened and then tested as set forth in said columns 10-11 citation as instantly claimed contrary to the allegation of applicants. Thus, the rejection based on Daniels et al. is deemed proper and therefore maintained.

CLAIMS OBJECTIONS

Claims 3, 4, 10, 11, 33, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

This application continues to contain claims 5, 12-17, and 22-31; drawn to an invention nonelected without traverse in the Paper filed 10/10/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 22, 2005


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER